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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/926,277 09/05/97 VACHRIS

P 6357-19259

EXAMINER

MM91/1122

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ART UNIT

PAPER NUMBER

2877

DATE MAILED:

11/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/926,277

Applicant(s)

VACHRIS et al

Examiner

Richard Rosenberger

Group Art Unit

2877



☒ Responsive to communication(s) filed on Oct 20, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 45-95 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 45-95 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 19, 21

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. There appears to be some confusion as to what claims are present in this application.

The application was originally filed with claims 1-44.

An amendment was filed November 10, 1998, canceling claim 17. And adding new claims 45 and 46. Thus the claims that were pending at after entry of that amendment were claims 1-16, and 18-46.

On February 7, 2000 an amendment was filed canceling claims 1-16, 18-23 and 38-44 and adding claims 47-63. The claims that were pending after the entry of that amendment were claims 24-37 and 45-63. These are the claims that were rejected in the office action mailed April 21, 2000.

However, on 20 October 2000, an "preliminary amendment" was filed with a request for a Continued Prosecution Application (CPA). This amendment requested the cancellation of claims 1-44, of which claims 1-23 have already been cancelled by the amendments of November 10, 1998 (claim 17) and February 7, 2000 (claims 1-16, 18-23). Additionally, the amendment requested the entry of new claims 45-77; however, claims numbered 45-63 have already been previously added by the amendments of November 10, 1998 (claims 45 and 46) and February 7, 2000 (claims 47-63).

37 CFR § 1.126 requires that "[w]hen claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not)".

Accordingly, the claims added by claims the amendment filed October 20, 2000 have been renumbered as claims 64-95 so that they comply with 37 CFR § 1.126.

The claims now pending in this application are claims 45-95. Claim 17 was cancelled by the amendment filed 10 November 10, 1998; claims 1-16, 18-23 and 38-44 were cancelled by the amendment of February 7, 2000. The request to cancel claims 1-44 in the amendment filed October 20, 2000 has been taken to request the cancellation of claims 24-37, the only claims in that group that have not been previously cancelled.

Applicant needs to clarify which claims are intended to be pending in this application. It appears that claims 45-63 may not be intended to be active in this application.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 47 and 48 are rejected under 35 U.S.C. 112, first paragraph for not being properly supported by the specification as filed and under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what is being claimed and how what is being claimed relates to what is disclosed. These claims all call for a "single electrode device" having two electrodes; that is contradictory.

There is no disclosure to support what is claimed. There are two distinct general embodiments of the invention as disclosed. The first, shown in figures 1, 1A, 3, 4 and 5, has a single electrode device and uses the object being measured as a second electrodes. The second embodiment, shown in figure 2, is a two electrode device, with the object being measured contacting one of the electrodes, which is flexible, These claims are a confused mixture of the two general embodiments. The claims rejected above all call for a single electrode device with the object being used as an electrode, each having a power supply with a second lead for coupling to a relief object Thus the claims are clearly claiming the first and not the second embodiment; in the second embodiment the power supply is not "coupled" to the relief object. However, both claims also claim the presence of the second, flexible electrode. These they cannot be claiming the first embodiment, but are claiming the second, the first embodiment has no such flexible electrode, and is a single electrode device. Thus these claims are clearly both claiming and not claiming both embodiments in a unclear, confusing, and incorrect mixture of the two. The specification simply does not disclose a single electrode device with two electrodes which uses both the object being measured as an electrode and also uses a flexible second electrode.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 45, 46, and 64-78 are rejected under 35 U.S.C. 103(a) as obvious over Gaffney (WO 9716834).

Gaffney teaches the claimed use of a device with two electrodes, one of them being a flexible electrode, a light emitting layer between the electrodes, and a variable resistive layer between the flexible electrode and the light emitting layer. When a relief object is brought into contact with the flexible electrode, localized pressure gradients create a light image of the relief object. It would have been obvious to use any known variable resistive layer for that of Gaffney, the instant specification notes that the claimed variable resistive layers are known in the art (see the instant specification, page 15, line 1).

6. Claims 49-63 and 79-95 are are rejected under 35 U.S.C. 103(a) as being unpatentable over Derwent abstract XP-002080114, Derwent abstract XP-002080115 and the Abstract of Japanese patent 02126381.

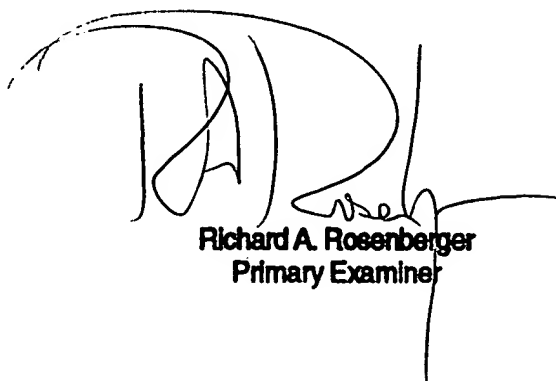
All three references teach the basic disclosed invention. The use of any known electroluminescent material, be it organic or inorganic, would have been obvious. Those of ordinary skill could have made the surface any desired shape to accommodate the relief object to be measured; it is well-known in the art that fingerprints are curved and that curved surfaces can better accommodate fingerprints than flat surfaces. Those in the art could form that various parts of the device by any known manufacturing technique and of any known materials appropriate to the construction.

7. Papers related to this application may be submitted to Group 2800 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The fax number is (703) 308-7722.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. A. Rosenberger whose telephone number is (703) 308-4804.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

R. A. Rosenberger
17 November 2000



Richard A. Rosenberger
Primary Examiner